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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/662,507	09/14/2000	Richard L. Smith	SUR-3645	2262

7590

06/28/2002

E Philip Koltos
Division Of General Law
Office Of The Solicitor Department Of The Interior
1849 C Street NW Room 6531
Washington, DC 20240

EXAMINER

BARRY, CHESTER T

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 06/28/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/662 507

Applicant(s)

SMITH, RICHARD L.

Examiner

Chester T. Barry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION

- Extensions of time may be available under the provisions of 37 CFR * 136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other _____

All prior-art based and applicant admission-based rejections of record set forth in the 1/16/02 Office action are incorporated herein by reference. The lack of enablement rejection is withdrawn.

In response to the §102(b) rejection of claims 1 and 4, Applicant argues ONLY that there is "nothing in Egli et al. about treating water to treat nitrate-contaminated drinking water" (Response, page 4). This argument was very carefully considered, but not found to be probative of the allowability of either claim 1 or claim 4 insofar as neither of claims 1 and 4 is directed to treating nitrate-contaminated **drinking** water. Note the conspicuous absence of "drinking water" as a limitation of claim 1 and claim 4. Note the equally conspicuous role "drinking water" plays in applicant's attempt to distinguish the claimed invention of claim 1 and claim 4 over Egli. Note also the conspicuous absence of the following argument: Egli fails to describe treating nitrate-contaminated water in a hydrogen-fed bioreactor with autotrophic, hydrogen oxidizing denitrifying bacteria. Until applicant deems such an argument worthwhile or prudent, the examiner will not consider it on the merits.

Similarly, the argument against the §103 rejection of claims 1 and 4 is not based on applicants failing to admit that Liessens teaches or suggests treating nitrate-contaminated water in a hydrogen-fed bioreactor with autotrophic, hydrogen oxidizing denitrifying bacteria. Instead, applicants state that the admission included statements that the plants are engineered to produce up to 50 cubic meters per day of water, that they are technically complex, that they require a commercial supply of hydrogen, and that trained experts are required to ensure an adequate function on a daily basis. This

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argument, even if true, is inapposite of the unpatentability of claims 1 and 4, however, at least for the reason that neither claim 1 nor claim 4 is limited by any of the following limitations: The equipment for carrying out the claimed method is not capable of producing as many as 50 cubic meters per day of water, that they are not technically complex, that they must operate without a commercial supply of hydrogen, and that trained experts cause the equipment to cease to function altogether.

As for the §102 rejection of claim 2 based on Tanaka, the examiner maintains that removal of compost from treated contaminated water effects the physical removal of nitrates within the compost from the contaminated water.

Claims 3,¹ 9 – 13 are rejected under 35 USC 102(b) as being anticipated by Egli. Applicant did not separately argue the features now recited in new dependent claims 9-13, all of which are dependent on claim 1 directly or indirectly. Accordingly, claims 9 – 13 stand or fall with claim 1.

Claims 3, 9 – 13 are rejected under 35 USC 103(a) as being obvious over applicant's admissions as to the state of the prior art. Applicant did not separately argue the features now recited in new dependent claims 9-13, all of which are dependent on claim 1 directly or indirectly. Accordingly, claims 9 – 13 stand or fall with claim 1.

Claims 3, 9 – 13 are rejected under 35 USC 102(e) as being anticipated by Tanaka.

¹ Claim 3 depends now from claim 11, not claim 1 as before the amendment. Applicant's failure to comply with 37 CFR 1.121 with respect to the marked up copy of claim 3 is waived (note "11" in claim 3 and "12" in marked up copy of claim 3).

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Applicant did not separately argue the features now recited in new dependent claims 9-13, all of which are dependent on claim 1 directly or indirectly. Accordingly, claims 9 – 13 stand or fall with claim 1.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chester T. Barry whose telephone number is 703-306-5921. The examiner can normally be reached on M, T, R, F 9 - 3 PM, W 9 - 1 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Simmons can be reached on 703-308-1972. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in dark ink, appearing to read 'Ce' followed by a long horizontal stroke.

Chester T. Barry
Primary Examiner
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June 26, 2002